

REMARKS/ARGUMENTS

The Office Action has been carefully considered. Claims 12-25 are withdrawn. Claims 1, 6-8, 26, and 31 are currently amended. Claims 1-11 and 26-32 are pending. In the Office Action, Claims 1-11 and 26-32 were rejected in the following manner.

1. Claims 6-7 and 31 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite.
2. Claims 1-11 and 26-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,996,015 to Day et al (“*Day*”) in view of Published U.S. Patent Application Pub. No. 2001/0044851 to Rothman et al. (“*Rothman*”).

§112 Rejections

Claims 6-7 and 31 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claim 6 is amended to clarify that media items are broadcast “to the user electronic device,” and that “said set of restrictive criteria comprises whether fewer than a substantial number of media items are delivered.” Thus, Applicants respectfully submit that Claim 6 definitely includes an element specifying that there is an upper limit (“a substantial number”) on the number of media items that may be delivered. Claims 7 and 31 recite similar elements. Applicants respectfully submit that Claims 6-7 and 31 are definite under 35 U.S.C. §112, second paragraph, and request reconsideration and withdrawal of the rejection.

§103 Rejections

Claims 1-11 and 26-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Day* in view of *Rothman*.

To establish *prima facie* obviousness of a claimed invention, all of the claim recitations must be taught or suggested by the prior art; (*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)), and “all words in a claim must be considered in judging the patentability of that claim against the prior art;” (*In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). Further, if prior art, in any material respect teaches away from the claimed invention, the art cannot be used to support an obviousness rejection. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed Cir. 1997). Moreover, if a modification would render a reference unsatisfactory for its intended purpose, the suggested modification / combination is impermissible. See MPEP § 2143.01.

Amended Claim 1 recites as follows:

A computer implemented method of delivering digital media items to a user electronic device, the method comprising:

obtaining at the computer a playlist comprising a sequentially ordered plurality of digital media items that satisfies a set of restrictive criteria;

playing said playlist by the computer, wherein playing said playlist comprises sequentially delivering to the user electronic device, via a computer network, said sequentially ordered plurality of digital media items; and

while the computer is playing the playlist:

receiving, from the user electronic device, an indication to add a requested digital media item to the playlist;

evaluating whether adding the requested digital media item to the playlist would satisfy the set of restrictive criteria; and

when the set of restrictive criteria is satisfied, selectively adding the indication of the requested digital media item to the playlist for delivery to the user electronic device subsequent to receipt of the request.

Applicants respectfully submit that the Office Action has failed to state a *prima facie* case that Claim 1 is obvious at least because *Day* in view of *Rothman* does not teach or suggest several elements of Claim 1. Applicants

Day in view of Rothman does not teach or suggest a playlist that satisfies a set of restrictive criteria

Day in view of *Rothman* does not teach or suggest “a playlist... that satisfies a set of restrictive criteria,” as claimed in Claim 1. Applicants agree with the Office Action that *Day* does not teach or suggest “a playlist... that satisfies a set of restrictive criteria,” as claimed in Claim 1. Applicants respectfully disagree that *Rothman* remedies this deficiency.

Rothman is directed towards “real-time streaming media over a communications network, using a streaming media server system for efficient delivery of a plurality of streams including live, simulated live or looping programming, relayed streams, and on-demand media...” Abstract.

The Office Action asserts that *Rothman* at ¶ [97] discloses “a playlist would satisfy a set of restrictive criteria.” In ¶ [97], *Rothman* discloses that the DMCA governs Internet commercial broadcasters, noting that “[o]ne of the requirements of the DMCA is that the listeners **should not be able to predict the playlist** in advance. If a station has **a static playlist, on-demand broadcasting is perfectly predictable.**” *Rothman* goes on to disclose that “simulated live

broadcasting” is infeasible in certain situations. *Rothman* does not disclose whether “simulated live broadcasting” is predictable.

Summing up, *Rothman* discloses merely that under the DMCA, listeners to commercial Internet broadcasts should not be able to predict the playlist, and that static playlist on-demand broadcasting is predictable. It follows logically that *Rothman* discloses that static playlist on-demand broadcasting does not satisfy the requirements of the DMCA. *Rothman* does not ever return to the subject of the DMCA. Applicants have reviewed *Rothman* in detail without discerning that it could be said to teach or even suggest “a playlist would satisfy a set of restrictive criteria.” Accordingly, Applicants respectfully submit that the Office Action has failed to state a *prima facie* case that Claim 1 is obvious at least because *Day* in view of *Rothman* does not teach or suggest “a playlist... that satisfies a set of restrictive criteria,” as claimed in Claim 1.

Day in view of Rothman does not teach or suggest selectively adding an item to a playlist while it is playing

Applicants have also made several revisions to Claim 1 in order to more clearly set out the scope of the claim, and Applicants respectfully request that these amendments be entered. Applicants respectfully submit that *Day* in view of *Rothman* (*Day* in particular) does not read on the clarified scope of Claim 1.

Day is directed towards a multimedia server in which “client selected video files are seamlessly joined together at the server just prior to file delivery from the server. A seamless sequential playlist or dynamically created playlist is assembled... and the resources needed to deliver and play the playlist are reserved in advance....” Abstract.

Applicants respectfully submit that *Day*, whether considered alone or in light of *Rothman*, does not teach or even suggest allowing users to request modifications to a preexisting playlist while the playlist is playing (i.e., being delivered to a user electronic device). In particular, *Day* in view of *Rothman* fails to teach or suggest “receiving... an indication to add a requested digital media item to the playlist [while the playlist is playing]”; “evaluating whether adding the requested digital media item to the playlist would satisfy the set of restrictive criteria [while the playlist is playing]”; and “selectively adding the indication of the requested digital media item to the playlist for delivery to the user electronic device subsequent to receipt of the request [while the playlist is playing].”

For at least the reasons discussed above, Applicants respectfully submit that the Office Action has failed to state a *prima facie* case that Claim 1 is obvious. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of Claim 1.

Amended Independent Claim 26 recites similar elements to those discussed above regarding Claim 1. Therefore, Applicants respectfully submit that Claim 26 is allowable at least by the same and/or similar reasoning.

Claims 2-11 and 27-32 are allowable at least by dependency and because they recite independently patentable subject matter

Claims 2-11 and 27-32 depend from Claims 1 and 26, respectively, and are allowable at least by dependency. In addition, Claims 2-11 and 27-32 recite additional patentable subject matter.

For example, *Day* in view of *Rothman* does not teach or suggest “inserting a requested media item at a random position in the playlist [while the playlist is playing],” as claimed in Claim 3. At most, *Day* in view of *Rothman* discloses merely that a video stream comprising video segments plays from start to finish in a predetermined order. *See, e.g., Day* col. 6 lines 37-64 (“the first selected video segment begins to play 311 as the data stream is initiated ‘on-the-fly’ While the first selected video segment is playing..., a determination is made 313 as to whether there are more segments to be presented.”) Accordingly, Applicants respectfully submit that *Day* in view of *Rothman* falls far short of teaching or suggesting “inserting a requested media item at a random position in the playlist,” as claimed in Claim 3.

For another example, *Day* in view of *Rothman* does not teach or suggest evaluating “whether the playlist complies with the Digital Millennium Copyright Act requirement for obtaining a statutory license,” as claimed in Claim 5. At most *Day* in view of *Rothman* discloses the mere existence of the DMCA and that predictable playlists do not comply with its requirements. *See Rothman* ¶ [024]. Accordingly, Applicants respectfully submit that *Day* in view of *Rothman* falls far short of teaching or suggesting evaluating “whether the playlist complies with the Digital Millennium Copyright Act requirement for obtaining a statutory license,” as claimed in Claim 5.

For still another example, *Day* in view of *Rothman* does not teach or suggest that the “set of restrictive criteria comprises whether fewer than a substantial number of media items are delivered,” as claimed in Claim 6. Similarly, *Day* in view of *Rothman* does not teach or suggest that the “set of restrictive criteria comprises whether fewer than a substantial number of

requested media items are delivered at a time that the user electronic device is informed the requested media items will be delivered,” as claimed in Claim 7. At most, *Day* in view of *Rothman* teaches that a playlist may be assembled and transmitted. *See Day* Abstract. Claims 27 and 31 recite a similar element that is not taught or suggested by the cited art.

For yet another example, *Day* in view of *Rothman* does not teach or suggest “broadcasting media items... in compliance with the Digital Millennium Copyright Act requirement for obtaining a statutory license,” as claimed in Claim 8. At most *Day* in view of *Rothman* discloses the mere existence of the DMCA.

For an additional example, *Day* in view of *Rothman* does not teach or suggest “limiting the number of requests from the user electronic device,” as claimed in Claim 10. At most, *Day* in view of *Rothman* discloses merely that “files may be selected individually for presentation or such files may be selected in groups.” *Day* col. 5 lines 53-59. *Day*’s method of selective file selection has nothing to do with “limiting the number of requests from the user electronic device,” as claimed in Claim 10. Accordingly, *Day* in view of *Rothman* does not teach or suggest that element of Claim 10.

For a final example, *Day* in view of *Rothman* does not teach or suggest that the set of restrictive criteria comprises “a set of group preferences to each network media channel,” as claimed in Claim 32.

For at least the reasons discussed above, Applicants respectfully submit that the Office Action has failed to state a *prima facie* case that Claims 2-11 and 27-32 are obvious in light of the cited art. Applicants therefore respectfully request reconsideration and withdrawal of the rejections of Claims 2-11 and 27-32.

One of ordinary skill would have had no motivation to combine the cited references.

The preceding arguments are believed sufficient to address the issues raised in the Office Action. Therefore, Applicants need not spend a considerable time discussing the lack of motivation to combine the cited references. However, under the Supreme Court’s most recent ruling on the matter, it remains important to avoid the use of hindsight reasoning when combining references. *See KSR International Co. v. Teleflex Inc.*, 550 U.S. –, 127 S.Ct. 1727, 1742; *see also Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 36, 86 S.Ct. 684 (warning against a “temptation to read into the prior art the teachings of the invention in issue” and instructing courts to “guard against slipping into the use of hindsight”).

Applicants respectfully submit that the only way to assert that the pending claims are obvious would be to “engage in a hindsight reconstruction of the claimed invention, using the applicant’s structure as a template and selecting elements from references to fill the gaps.” *See In re Gorman*, 993 F.2d 982, 18 U.S.P.Q.2d 1885 (1991). Indeed, it is at least conceivable that the prior art may disclose broad teachings generally similar to some of the specific individual elements of the pending claims. Nonetheless, it remains strictly forbidden to “use hindsight reconstruction to pick and choose among isolated disclosures in the prior art” to determine that the pending claims are obvious. *See Ecolochem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 56 U.S.P.Q.2d 1065 (2000). As stated in MPEP § 2141.01, “It is difficult but necessary that the decisionmaker forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art.”

Applicants respectfully submit that only the blueprint provided by Applicants’ claims can provide any plausible motivation to pick and choose from among the countless isolated elements from *Day* and *Rothman* in the manner asserted in the Office Action. As such hindsight reconstruction is inappropriate, Applicants respectfully submit that for this additional reason, the Office Action has failed to state a prima facie case of obviousness for Claims 1-11 and 26-32.

CONCLUSION

For at least the reasons above, Applicants respectfully submit that all pending claims are allowable and request that the Examiner permit these claims to proceed to issuance. Although additional arguments are believed to exist for distinguishing the cited documents, the arguments presented are believed sufficient to address the Examiner's rejections. Likewise, failure of the Applicants to respond to a position taken by the Examiner is not an indication of acceptance or acquiescence of the Examiner's position. Instead, it is believed that the Examiner's positions are rendered moot by the foregoing arguments, and it is therefore not believed necessary to respond to every position taken by the Examiner with which Applicants do not agree.

The Examiner is respectfully requested to contact the undersigned at the telephone number below if there are any remaining questions regarding this application.

We believe the appropriate fees accompany this transmission. If, however, insufficient fee payment or fee overpayment occurs, the amount may be withdrawn or deposited from/to AXIOS Law Group's deposit account. The deposit account number is 50-4051.

Respectfully submitted,
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